

REMARKS

In response to the outstanding Office Action, Applicants submit herewith a substitute specification, excluding the claims, to replace the specification as originally filed, under the provisions of 37 CFR 1.125(b). It is hereby stated that the enclosed specification contains no new matter, but is based on the specification as originally filed (37 CFR 1.125(b)(1)). As required under 37 CFR 1.125(b)(2), a marked-up copy of the substitute specification is also enclosed herewith, showing the matter being added to and the matter being deleted from the specification.

One change in terminology made throughout the substitute specification is to change the term "optical security film" to --optical security coating--. It is clear from the methods as originally described in the specification that this invention relates to application of a coating to a substrate, not a pre-formed adhesive tape, so that "coating" is a more accurate description than "film". The use of the term "film" elsewhere in the original specification to refer to this coating was a result of selection of a less accurate term in translation of the original Spanish specification from Spanish to English. This is clear when reviewing the original description of the various alternative methods of applying the coating, particularly application of a lacquer which then must be dried or cured. Clearly, this is a coating, and not a pre-formed adhesive film or tape. Thus, on page 6 of the original specification, lines 3 to 4 of the last complete paragraph, it was stated: "The removable coating consisting of the type-Y lacquer (the coating with the optical image engraved) may be any color...". It is therefore submitted that no new matter has been added to the specification, and that it is based on the specification as originally filed and the original Spanish specification, being merely a correction in terminology for consistency throughout the specification. It is respectfully requested that the enclosed substitute specification be entered to

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replace the specification as originally filed.

In addition, original claims 1 to 5 of this application have been cancelled and replaced with new claims 6 to 22 which are believed to overcome the rejections in paragraphs 1 to 3 of the Office Action. Claims 6 to 15 replace original claims 1 to 5 and are directed to an optical security device, while new claims 16 to 22 are directed to a method of making the device.

In paragraph 1, the Examiner rejected original claims 1 and 3 to 5 under 35 U.S.C. 112, second paragraph on the basis that these claims contained vague and indefinite language, lack of antecedent basis for some terms used, and improper alternative language. New claims 6 to 22 have been rewritten to avoid the language objected to by the Examiner. In particular, new independent claims 6 and 15 positively define each element of the optical security article and remove any indefiniteness. The dependent claims are also clear in scope and do not include any alternative language or terms lacking antecedent basis. Reconsideration and reversal of the rejection in paragraph 1 is therefore respectfully requested.

In paragraph 3, the Examiner rejected original claims 1 to 5 as obvious in view of Curiel. It is submitted that new claims 6 to 15 are all fully distinguished from this reference. The Examiner argued that Curiel discloses a tamper evident article with a transparent outer film, an adhesive, a hologram, an adhesive having differential adhesion properties, a polyester film, and an adhesive film. The transparent outer film contains hologram particles, and the Examiner argued that this is releasably attached to the other hologram containing layer or substrate. However, Curiel and the other references cited by the Examiner all relate to tamper proof tape in which the appearance of the tape itself, or the underlying substrate, is changed when the tape is removed. In Curiel, the object is to prevent easy counterfeiting or alteration of an item such as a temporary vehicle registration plate by photocopying, which is quite

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different from the object of the present invention. A temporary registration plate has a date of expiration added by the car dealer at the time of sale, and it is important to ensure that such temporary plates cannot be duplicated and that the information provided by the dealer cannot readily be altered. Thus, a hologram pattern is provided within the zone where the expiry date is added, to resist photocopying. Once the dealer has inserted the expiry date information, an adhesively bonded transparent tape is applied over the inserted information, and this is covered with a write-resistant coating.

The tape in some embodiments of Curiel incorporates a hologram to prevent use of conventional tape material. In other cases, an outer film is applied over a hologram which has adhesive characteristics. Curiel describes a pre-formed tape member of transparent polyester or polyolefin material which has an adhesive on one side originally covered by a protective web 16 (column 6, lines 25 to 34). The protective web 16 is removed, and the tape 20 is then urged downwardly to overly the information on the substrate, with the adhesive layer downwards to adhere it to the substrate. In another embodiment, a hologram is secured to the lower surface of an outer transparent film so as to overly the data. In Figure 6, the outer film 42 and adhesive layer 102 contain hologram particles. The adhesive layer may have variable adhesive properties such that, if an attempt is made to remove the outer film, the less adhesive parts will be lifted and the more adhesive parts will remain on the substrate. Any attempt to remove the hologram as a unit will be defeated (column 10, lines 36-37). Similarly, in the embodiment of Figure 10, any effort to remove the outer film 182 will "irreversibly fracture hologram 186-188 and remove portions of the substrate". (see column 10, lines 56 to 59). Thus, regardless of whether the hologram is provided in the tape, in an underlying adhesive layer, or both, the primary objective in Curiel is to ensure that the tape cannot be removed without also altering or damaging the

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information. Instead, Curiel's tape is designed to be non-removable without difficulty and, if attempted to be removed, causes destruction or permanent alteration of the substrate or information contained on the substrate, as described in column 7, lines 7 to 10, for example.

It is therefore submitted that new claims 6 and 15 are fully distinguished from Curiel and all other cited references, which involve use of a tape, not a coating, and damaging or altering the appearance of a tamper resistant seal and the underlying substrate on removal of the seal.

Claims 7 to 14 depend from claim 6 and are distinguished from Curiel for the same reasons as claim 6, and additionally since these claims define other features not described or suggested by Curiel or any other reference. Referring to claim 7, Curiel does not suggest any transparent release coating applied to the substrate between the substrate and the tape, and such a coating would be contrary to Curiel's objectives of preventing easy removal of the tape. Similarly, referring to claim 8, Curiel's tape with adhesive does not include any stripping agents which prevent permanent adhesion of the optical security device to the substrate. In Curiel, although in some cases part of the device may contain lower strength adhesives in certain regions, there will still be adhesive material to resist removal without damaging the underlying substrate, such that both the hologram and the underlying substrate is damaged or altered by any attempt to remove the tape.

Referring to claim 9, the tape in Curiel is transparent, in order to reveal the registration information underneath the tape. It would be contrary to Curiel's teachings to make the tape opaque, or to have an opaque tape completely concealing the underlying information. Referring to claim 12, Curiel also does not describe or suggest a series of two coatings of lacquer material applied to the substrate, with the second coating being engraved with an optical image, the second coating or lacquer material

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Thus, referring to claim 16, Curiel does not suggest removable application of an optical security coating to the substrate, where the coating has an adhesive component to resist accidental removal of the coating but to permit **complete** removal of the coating by scratching or scraping it off the substrate. It is therefore submitted that independent claim 16 is also fully distinguished from Curiel.

Claims 17 to 22 depend from claim 16 and are distinguished from Curiel from the same reasons as claim 16, and additionally since these claims define other method steps not suggested by Curiel. Referring to claim 17, Curiel does not suggest application of two successive coatings to the substrate, with the first coating having stripping properties to prevent permanent adhesion of the second coating, and the second coating containing the engraved optical security elements. Referring to claim 18, which depends from claim 17, Curiel further does not suggest a first coating comprising a lacquer. Referring to claim 19, Curiel does not suggest application of a removable coating by flexography. The steps of claims 20 to 22 are also completely lacking from Curiel.

It is therefore submitted that method claims 16 to 22 are also fully distinguished from Curiel, and allowance of these claims as well as claims 6 to 15 is respectfully requested.

The features of the claimed invention lacking from Curiel are also lacking from the other references cited by the Examiner. These generally all relate to tamper evident labels which are designed to alter or damage the underlying substrate on removal, and which are pre-formed labels or tapes rather than coatings.

It is submitted that the enclosed substitute specification and new claims submitted herewith deal with all of the rejections raised by the Examiner in the current Office Action, and that this application should now be in condition in all respects for allowance. early notice to this effect is earnestly solicited. If there are any outstanding

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rejections which could be dealt with by means of a telephone interview, the Examiner is encouraged to contact the undersigned representative.

Respectfully submitted,

Dated: February 7, 2002

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Docket No.: 7544-PA01

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